REMARKS/ARGUMENT

The abstract has been amended. Applicants request amendment of the existing abstract by replacement abstract attached on a separate sheet to this amendment.

Claims 1-28 are currently pending.

The Office Action rejected claims 1-28 under 35 U.S.C. § 103 as obvious over CA 2255456 ("Siray"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The pending § 103 rejection relies upon the assumption that the disclosure at page 4, line 17 of Siray is accurate. However, as demonstrated by the concurrently submitted Rule 132 declaration by Mustafa Siray (a named inventor on Siray), this is not the case. Because the pending rejection is based upon an erroneous assumption, the rejection itself is erroneous and should be withdrawn.

More specifically, in his declaration, Siray states that:

- Siray discloses silica having a tamped density of at least 70 g/l. With particular reference to Siray's wax-coated silica, Siray's abstract, Siray's claim 3 and the entire remainder of Siray's disclosure require the compacted density of wax-coated silica to be at least 70 g/l (70-140 g/l). This is consistent with Siray's understanding that the silica disclosed in Siray, including wax-coated silica, has a tamped density of at least 70 g/l. (Paragraph 3).
- The disclosure at page 4, line 17 is a typographical error. This line should have stated that the tamped density was 70-140 g/l in accordance with the remainder of

Siray's disclosure. Siray never considered silica having a tamped density of 7-140 g/l to be part of the invention in Siray. (Paragraph 4).

- Siray agrees with the analysis of Siray's exemplified compositions which is set forth in the Schubert declaration (submitted August 20, 2007). In his declaration, Schubert demonstrated that none of Siray's examples disclose precipitated silica having a tamped density of 20 to less than 70 g/l or a DBP number of 350-400 g/100 g, let alone precipitated silica having both of these characteristics. Also in the Schubert declaration, it was demonstrated that following the preparation methods exemplified in Siray would lead to silica having tamped density of 72-85 g/l. and a DBP number of 320-333 g/100g. Schubert's findings and analysis are consistent with Siray's understanding of the inventive silica disclosed in Siray. (Paragrapah 5).

Thus, according to Siray himself, Siray discloses silica having a tamped density of at least 70 g/l --- it does not teach or suggest silica having a tamped density of less than 70 g/l. The disclosure in Siray upon which the Office Action has based the pending rejection (page 4, line 17) is nothing more than a typographical error. Nowhere does Siray teach or suggest silica having a tamped density of less than 70 g/l.

The claimed invention relates to precipitated silica having a low tamped density (20 to less than 70 g/l) and a high DBP number (350-400 g/100 g). Siray neither teaches nor suggests such silica having both of these characteristics, let alone all of the elements required by the claims.

As noted above, Siray himself states that Siray discloses silica having a tamped density of at least 70 g/l, and that the disclosure at page 4, line 17 is nothing more than a typographical error which clearly should have been 70-140 g/l in accordance with the remainder of Siray's disclosure, not 7-140 g/l, a range for which no other support or disclosure exists.

Furthermore, Applicants note that in the the Schubert declaration (at par. 2), it is demonstrated that none of Siray's examples disclose precipitated silica having a tamped density of 20 to less than 70 g/l or a DBP number of 350-400 g/100 g, let alone precipitated silica having both of these characteristics. Thus, Siray does not disclose the claimed silica.

In contrast, the amended claims require the tamped density to be less than 70. In fact, claims 27 and 28 require the tamped density to be 60 or less. Accordingly, no overlap exists with respect to tamped density of the claimed silica and and the compacted density of Siray's silica.

For at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Moreover, nothing in Siray would have motivated one skilled in the art to modify the silica disclosed therein to arrive at the claimed precipitated silica. More specifically, nothing would lead one skilled in the art to the claimed precipitated silica having both low tamped density (20 to less than 70 g/l) and high DBP number (350-400 g/100g). Following the preparation methods set forth in Siray, one skilled in the art would obtain silica having tamped density of 72-85 g/l and a DBP number of 320-333 g/100g, (see, Schubert declaration, par. 3), and no teaching or suggestion exists concerning how to modify the preparation methods to achieve precipitated silica having both low tamped density (20 to less than 70 g/l) and high DBP number (350-400 g/100g). (See, Schubert declaration, pars. 3-4). In other words, following

Siray would not lead one skilled in the art to the claimed silica. For this reason as well, Applicants respectfully submit that no *prima facie* case of obviousness exists, and that the § 103 should be withdrawn.

Finally, even assuming that a *prima facie* case of obviousness exists (which, as explained above, is not the case), sufficient data demonstrating superior and beneficial results associated with the claimed silica are disclosed in the present application to rebut any such hypothetical case of obviousness. More specifically, as demonstrated on page 7 of the present application, the invention silicas possess improved matting efficiency over comparative silicas.

As explained in the Schubert declaration, examples 1, 3, 4 and 5 correspond to the invention silicas. (See, Schubert declaration, par. 5). These examples all have gloss 60° values which are surprisingly lower than the gloss value of Example 2 (DBP number of 333 g/100 g) and the comparative composition containing Acematt HK 450. (See, Schubert declaration, par. 5). This difference in matting efficiency between the invention silicas and the comparative silicas was surprising and unexpected given the similarity of the silicas. (See, Schubert declaration, par. 6). The difference in matting efficiency between the invention silicas and the comparative silicas demonstrates the surprising and unexpected benefit derived from having properties associated with the invention silicas. (See, Schubert declaration, par. 8). What's more, the improved matting efficiency associated with the invention silicas are commercially significant -- clearly, silicas which possess more effective matting properties are more commercially viable than less effective silicas. (See, Schubert declaration, par. 9).

In view of the above, Applicants respectfully submit that sufficient data exists demonstrating the unexpected and surprising matting properties of the claimed silicas to rebut any hypothetical *prima facie* case of obviousness which might exist.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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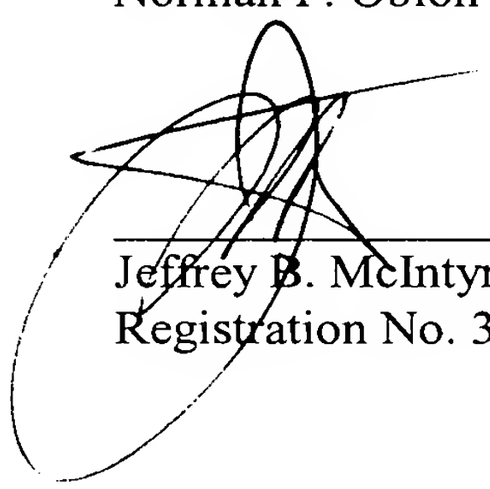

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ABSTRACT OF THE DISCLOSURE

A precipitated silica characterized by

BET	350 - 550 m^2/g
DBP number	350 - 400 g/100 g
d_{50}	5 - 15 μm, and
tamped density	20 to less than 70 g/l.

~~The invention relates to precipitated silicas having improved matting efficiency.~~